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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,294	10/06/2000	Masaaki Usui	107531	8349
25944	7590	11/05/2003	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,294

Applicant(s)

USUI, MASA AKI

Examiner

St fano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following application has been reviewed. Original claims 1-7 are pending. The rejection is as stated below:

Specification

2. The abstract of the disclosure is objected to because of undue length. Correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, and 5-7 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schutzer et al. (hereinafter Schutzer) U.S. Patent 5,920,848.

Regarding independent claim 1, Schutzer discloses a method for the unified management of a plurality of assets using a computer network, comprising the steps of: a client computer notifying a financial institution server to send asset information to a unified asset management server, said client computer making a request to said unified asset management server to update a portfolio (column 11, lines 26-47); said unified asset management server making a request to said financial institution server to perform authentication (column 18, lines 10-17); said financial institution server providing authentication when said unified asset management server is the server specified in the notification from said client computer (column 9, lines 54-65); said unified asset management server making a request to said financial institution server to send said asset information, said financial institution server sending said asset information to said unified asset management server (column 11-12, lines 57-15); said unified asset management server

updating a portfolio based on said asset information received and said unified asset management server sending an updated portfolio to said client computer (column 17, lines 17-30).

Regarding independent claim 2, Schutzer discloses a method for the unified management of a plurality of assets using a computer network, comprising the steps of a financial institution server being notified to the effect that an event comprising a deposit/withdrawal process has taken place (column 10-11, lines 62-12); said financial institution server notifying a unified asset management server to the effect that asset information will be sent, said financial institution server sending said asset information to said unified asset management server (column 11-12, lines 57-15); said unified asset management server updating a portfolio based on said asset information received and said unified asset management server sending an updated portfolio to a client computer (column 17, lines 17-30).

Claim 5, the unified management of a plurality of assets using a computer network for the step of sending said updated portfolio to an adviser server in order to receive advice (column 6, lines 54-67).

Regarding independent claim 6, a unified asset management system comprising a plurality of assets databases corresponding to a plurality of financial institutions, a plurality of authentication information databases corresponding to said plurality of financial institutions, a

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portfolio database for storing portfolio information related to total assets in said plurality of financial institutions (column 11, lines 26-47 and column 7, lines 43-64); a unified asset management server for receiving asset information from said plurality of financial institutions and storing same respectively in said plurality of asset databases, and, in addition, for preparing said portfolio based on said plurality of asset databases and storing same in said portfolio database (column 11-12, lines 57-15); an authentication database for performing user authentication, an asset management database for managing a user's assets, a transaction management database for storing transaction information related to a user's assets, an event notification unit, which, when a transaction occurs, notifies said unified asset management server to that effect (column 7, lines 43-64); and a financial institution server which is connected to said authentication database, said asset management database, and said transaction management database wherein said financial institution server sends asset information to said unified asset management server after the notification from said event notification unit (column 11, lines 26-47).

Regarding independent claim 7, Schutzer discloses a unified asset management system comprising: a plurality of assets databases corresponding to a plurality of financial institutions; a plurality of authentication information databases corresponding to said plurality of financial institutions, a portfolio database for storing portfolio information related to total assets in said

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plurality of financial institutions (column 11, lines 26-47 and column 7, lines 43-64); a clock/calendar apparatus (column 17, lines 47-50), a unified asset management server for receiving asset information from said plurality of financial institutions and storing same respectively in said plurality of asset databases, and, in addition, for preparing said portfolio based on said plurality of asset databases and storing same in said portfolio database (column 11-12, lines 57-15); an authentication database for performing user authentication; an asset management database for managing a user's assets, a transaction management database for storing transaction information related to a user's assets, and a financial institution server connected to said authentication database, said asset management database, and said transaction management database (column 7, lines 43-64), wherein said unified asset management server receives a signal from said clock/calendar apparatus, and makes a request to said financial institution server to send asset information, and said financial institution server receives a signal from said second clock/calendar apparatus and based on this signal makes a determination as to whether or not the request from said unified asset management server was made within a predetermined period of time, and, in addition, sends said asset information on the basis of the results of this determination (column 16, line 50 thru column 17, line 50).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schutzer et al. (hereinafter Schutzer).

Regarding independent claim 3, Schutzer teaches a method for the unified management of a plurality of assets using a computer network, comprising the steps of a client computer making a request to a financial institution server to perform authentication, said financial institution server providing authentication, said client computer making a request to said

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financial institution server to execute a prescribed transaction (column 9, lines 54-65); said financial institution server notifying said client computer of the results of the execution of said transaction (column 11, lines 26-47); said client computer making a request to said unified asset management server to update a portfolio (column 17, lines 17-30); said unified asset management server making a request to said financial institution server to perform authentication, said financial institution server providing authentication (column 9, lines 54-65); said unified asset management server making a request to said financial institution server to send said asset information, said financial institution server sending said asset information to said unified asset management server (column 11-12, lines 57-15); said unified asset management server updating a portfolio based on said asset information received and said unified asset management server sending an updated portfolio to said client computer (column 17, lines 17-30).

Schutzer fails to teach that the verification/authentication is made within a prescribed time from the execution of the transaction. Official Notice is taken that performing the verification/authentication in a prescribed time limit is old and well known in the financial arts. Therefore it would have been obvious to someone of ordinary skill in the art that the teachings of Schutzer could be modified to specify verification/authentication in a prescribed time limit because it provides an efficient system for validating information before a transaction is completed to ensure correct procedures.

Regarding independent claim 4, Schutzer teaches a method for the unified management of a plurality of assets using a computer network, comprising the steps of a unified asset management server being started up automatically by a timer (column 16-17, lines 50-12); said unified asset management server making a request to said financial institution server to perform authentication, said financial institution server providing authentication (column 9, lines 54-65); said unified asset management server making a request to said financial institution server to send said asset information (column 11, lines 26-47); said financial institution server sending said asset information to said unified asset management server (column 11-12, lines 57-15); said unified asset management server updating a portfolio based on the received said asset information; and said unified asset management server sending an updated portfolio to said client computer (column 17, lines 17-30).

Schutzer fails to teach that the verification/authentication is made within a prescribed time from the execution of the transaction. Official Notice is taken that performing the verification/authentication in a prescribed time limit is old and well known in the financial arts. Therefore it would have been obvious to someone of ordinary skill in the art that the teachings of Schutzer could be modified to specify verification/authentication in a prescribed time limit because it provides an efficient system for validating information before a transaction is completed to ensure correct procedures.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Cwenar, US Patent 5,893,079 Apr. 6, 1999. System for receiving, processing, creating, storing and disseminating investment information.
- b) Motoyama, US Patent 5,913,202 Jun. 15, 1999. Financial information intermediary system.
- c) Kane, US Patent 6,317,728 Nov. 13, 2001. Securities and commodities trading system.
- d) Keiser et al., US Patent 6,505,174 Jan. 7, 2003. Computer-implemented securities trading system with a virtual specialist function.
- e) Wallman, US Patent 6,601,044 Jul. 29, 2003. Method and apparatus for enabling individual or smaller investors or others to create and manage a portfolio of securities or other assets or liabilities on a cost effective basis.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
October 29, 2003


HANI M. KAZIMI
PRIMARY EXAMINER